

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

November 3, 2004
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Sharp Kabushiki Kaisha,
a/t/a Sharp Corporation
v.
ThinkSharp, Inc.

Opposition No. 91118745
to application Serial No. 75652878
filed on February 26, 1999

Request for Reconsideration

Robert W. Adams and Diane M. Byers of Nixon & Vanderhye P.C.
for Sharp Kabushiki Kaisha, a/t/a Sharp Corporation.

Sherry H. Flax of Saul Ewing LLP for ThinkSharp, Inc.

Before Seeherman, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

The Board, in a decision dated March 31, 2004,
dismissed the opposition of Sharp Kabushiki Kaisha a/t/a
Sharp Corporation to ThinkSharp Inc.'s application to
register the mark THINKSHARP for "computer software for use
as education programs in the fields of problem solving and
critical thinking, pre-recorded videocassette tapes

featuring education programs in the field of problem solving and critical thinking; and CD-ROMS containing education programs" in class 16; and "educational services, namely providing information, conducting educational seminars and distributing education materials via classroom instruction, the global computer information network and satellite transmission, in the fields of problem solving and critical thinking" in class 41.

The Board found that applicant's mark THINKSHARP for the identified goods was not likely to cause confusion with opposer's previously used and registered mark SHARP for computers, videocassette players and CD-ROM players. In addition, the Board found that opposer did not properly plead a claim of dilution because opposer failed to plead that its SHARP mark had become famous prior to applicant's use of its mark. Further, the Board found that opposer failed to timely raise a claim of res judicata based on a prior opposition between the parties.

Opposer has filed a timely motion for reconsideration of the Board's decision; applicant has filed a brief in opposition thereto and opposer has filed a reply brief.¹

We turn first to the Board's finding that opposer first

¹ The Board notes that the time for applicant to file a brief and the time for opposer to file a reply brief were extended pursuant to the parties' stipulation.

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raised the claim of res judicata in its brief on the case, and thus the claim is untimely. Opposer maintains that the Board's finding is in error and that opposer first raised the claim of res judicata in its notice of reliance.

Opposer has submitted a copy of a cover letter that accompanied opposer's notice of reliance which identifies the prior opposition (Opposition No. 91123480) and includes a statement that "[o]pposer is relying on this judgment for its res judicata and/or collateral estoppel effect or its other legal/equitable effect upon the proceedings and issues in this Opposition No. [91118745]." ²

Inasmuch as applicant did not object to opposer's introduction of the judgment in Opposition No. 911234480 and opposer's cover letter clearly states that the judgment was being offered in support of its res judicata claim, we consider the claim to have been tried by the implied consent of applicant. Fed. R. Civ. P. 15(b). ³

Opposer argues that registration of applicant's involved application is barred by res judicata (claim preclusion) in view of Opposition No. 91123480 involving the

² As the result of an inadvertency, the cover letter was misplaced at the Board and, thus, was not part of the record reviewed at the time of the decision.

³ The better practice would have been for opposer to move for leave to amend the notice of opposition to assert that applicant was barred from seeking registration of its mark by the prior judgment.

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same parties. Opposition No. 91123480 involved applicant's application Serial No. 75721542 to register the mark THINKSHARP and design for goods and services which are identical to those in the application involved herein. Applicant filed an abandonment of that application prior to trial; the opposition was sustained and judgment was entered against applicant pursuant to Trademark Rule 2.135. It is opposer's position that the judgment in Opposition No. 91123480 operates as res judicata herein because the marks are virtually identical and the goods and services are the same. Opposer relies on *Miller Brewing Company v. Coy International Corporation*, 230 USPQ 675 (TTAB 1986) wherein the Board found that the doctrine of res judicata applied to an applicant's second mark because the second mark differed from the first mark only insignificantly, and applicant had abandoned the application for the first mark resulting in a judgment against the applicant. The Board in Miller Brewing Company at 678 stated that it "does not wish to encourage losing parties to insignificantly modify their marks after an adverse ruling and thereby avoid the res judicata effect of the prior adjudication."

Under the doctrine of res judicata or claim preclusion, the entry of a final judgment on the merits of a claim in a proceeding serves to preclude the relitigation of the same claim in a subsequent proceeding between the parties or

their privies, even in those cases where the prior judgment was the result of default. One of the purposes of res judicata is to promote judicial economy by preventing repetitive litigation.

This case, however, differs from *Miller Brewing Co. v. Coy International Corp.* in that this is not a situation where the applicant, after a judgment had been entered against it, adopted a second mark in an attempt to avoid the preclusive effect of a previous judgment. The applicant herein began using both its THINKSHARP (typed drawing form) and THINKSHARP and design marks at the same time and indeed both applications were pending at the time judgment was entered in Opposition No. 91123480. Applicant did not file its application to register the mark THINKSHARP in typed drawing form merely as an attempt to evade the preclusive effect of the judgment entered against it in the application to register THINKSHARP and design. Applicant was entitled to decide if it wanted to pursue the registration of only one of its marks, rather than defending two oppositions.

In view of the foregoing, we find that the doctrine of res judicata (claim preclusion) does not bar registration of the involved application.

We turn next to opposer's contention that the Board erred in finding that it failed to properly plead a claim of dilution. Opposer argues that "it used notice pleading to

properly set forth its dilution claim." (Brief, p. 5). We are not persuaded by opposer's contention. Where as here, a party seeks to assert a claim of dilution against a use-based application, the party alleging fame must plead that the mark had become famous prior to the applicant's use of the mark. See *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164 (TTAB 2001).⁴

Finally, opposer states that it requests reconsideration of the decision concerning likelihood of confusion in order to preserve its rights on appeal. Opposer has pointed to no specific findings which it believes are in error. We adhere to our findings of fact and conclusions of law that the relevant duPont factors favor a finding of no likelihood of confusion herein.

In view of the foregoing, opposer's request for reconsideration is denied with respect to the Board's finding that opposer failed to properly plead a claim of dilution and the Board's finding of no likelihood of confusion. The request for reconsideration is granted to the extent that we have considered opposer's claim of res

⁴ We note that opposer, in its brief, made several references to a likelihood of dilution. Nonetheless, as indicated, opposer failed to properly plead such a claim and the claim was not tried by the express or implied consent of applicant. We add that even if opposer had properly pled a claim of dilution, it did not prove such claim. See *Toro Co. v. ToroHead, Inc.*, *supra*.

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judicata, but find that it is not well taken and the opposition is dismissed on this ground.